

REMARKS

Claims 1-34 are pending in this application. Claims 29-34 are withdrawn from consideration as being drawn to a non-elected invention. Claims 15-20 were rejected under 35 U.S.C. § 101. Claims 1-28 were rejected under 35 U.S.C. § 112, first paragraph. Claims 1-28 were variously rejected under 35 U.S.C. § 112, second paragraph.

By this amendment, claims 3, 17, 19, 21 and 26 have been canceled, claims 1, 2, 4-6, 8-16, 18, 20, 22-25 and 28 have been amended without prejudice or disclaimer of any previously claimed subject matter. The amendments have been made to more clearly describe the claimed invention and support for the amendments can be found, *inter alia*, throughout the specification.

The amendments are made solely to promote prosecution without prejudice or disclaimer of any previously claimed subject matter. With respect to all amendments and cancelled claims, Applicant has not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicant expressly reserves the right to pursue prosecution of any presently excluded subject matter or claim embodiments in one or more future continuation and/or divisional application(s).

Applicant has carefully considered the points raised in the Office Action and believe that the Examiner's concerns have been addressed as described herein, thereby placing this case into condition for allowance.

Election/Restriction

Applicant appreciates the Examiner rejoining Groups I and II as listed in the restriction requirement laid out in the Office Action of September 11, 2003. Applicant acknowledges that the pending application has been restricted to the methods of Groups I and II, claims 1-28, and that claims 29-34 have been withdrawn from consideration in the pending application.

Specification

The Examiner has alleged that the specification as filed is not in the proper English vernacular and has consequently required filing of a substitute specification. Although Applicant acknowledges that the filed specification contains several grammatical errors, Applicant respectfully disagrees with the Examiner for the need of an entire substitute specification to address this matter.

Applicant respectfully submits that the filed specification provides a written description of the invention and of the manner and process of making the invention in English that is understandable to one of skill in the art. Submitted herein are amendments to correct and/or clarify grammatical errors identified in the specification and to add the SEQ ID NOs missing from pages 21 and 22. Thus amended, the specification provides a full and clear description of the invention in English.

Accordingly, Applicant respectfully submits that the objections to the specification have herein been addressed.

Rejection under 35 U.S.C. §101

Claims 15-20 were rejected under 35 U.S.C. § 101 as allegedly lacking patentable utility. As amended herein, claim 15 no longer recites “for further experiment,” thus Applicant respectfully submits that the claimed invention has patentable utility.

Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §101.

Rejections under 35 U.S.C. §112, first paragraph

Claims 1-28 were rejected under 35 U.S.C. §112, first paragraph, for allegedly not enabling any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with the claims. The pending claims have herein been amended to address the Examiners concerns under 35 U.S.C. §101 and 35 U.S.C. §112,

second paragraph. Applicant respectfully traverses this rejection under 35 U.S.C. §112, first paragraph as it may be applied to the amended claims.

As amended, the claimed invention is directed to a method for generating a *Drosophila* clipped *FRT* (cFRT) chromosome insensitive to a *P* transposase but sensitive to a yeast site-specific flippase recombinase (FLP). The claimed invention is also directed to a method for generating a *Drosophila* cFRT^{2L2R} chromosome insensitive to a *P* transposase but sensitive to a yeast site-specific FLP. The methods comprise causing a local, imprecise transposition in the FRT chromosome containing a *P[FRT]* insertion with a selectable marker gene, followed by steps of examining for sensitivity or insensitivity to *P* transposase and for sensitivity or insensitivity to FLP.

Applicant respectfully submits that the specification provides all the information required for one of skill in the art to make and use the invention as claimed without undue experimentation. See, for example, paragraphs [0058]-[0066] and [0083]-[0092]. For a *prima facie* case on non-enablement, the burden is on the Office to demonstrate that there is a reasonable basis to question the presumptively sufficient disclosure made by applicant. See, for example, *In re Wright*, 27 USPQ2d 1510 (Fed. Cir. 1993). Applicant respectfully submits that a *prima facie* case for lack of enablement has not been established.

Applicant respectfully submits that the pending claims are in compliance with the enablement requirements.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. §112, second paragraph

Claims 1-28 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although Applicant believes that the claims were sufficiently definite when considered in view of the specification and the understanding of those of skill in the art, Applicant has attempted to respond to the concerns of the Examiner in order to enhance clarity and to facilitate disposition of the present case.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

CONCLUSION

Applicant believes that all issues raised in the Office Action have been properly addressed in this response. Accordingly, reconsideration and allowance of the pending claims is respectfully requested. If the Examiner feels that a telephone interview would serve to facilitate resolution of any outstanding issues, the Examiner is encouraged to contact Applicant's representative at the telephone number below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 529872000100.

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Respectfully submitted,

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